| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/735,835 | 12/13/2000 | Vernon Keith Boland | 8598 | 5833 |

| | | | | |
|---|---|---|---|---|
| 26890 | 7590 | 07/05/2006 | | |

JAMES M. STOVER
NCR CORPORATION
1700 SOUTH PATTERSON BLVD, WHQ4
DAYTON, OH 45479

| EXAMINER |
|---|
| BORISSOV, IGOR N |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3639 | |

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

# MAILED

JUL 0 5 2006

# GROUP 3600

## BEFORE THE BOARD OF PATENT APPEALS
## AND INTERFERENCES

Application Number: 09/735,835
Filing Date: December 13, 2000
Appellant(s): BOLAND ET AL.

James M. Stover
<u>For Appellant</u>

## EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/11/2006 appealing from the Office action

mailed 5/19/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 6,298,330                    Gardenswartz et al.                    Oct. 2, 2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-5, 7-13 and 15-24 are rejected under 35 U.S.C. 102(e) as being unpatentable over Gardenswartz et al. (6,298,330).**

Gardenswartz et al. (Hereinafter Gardenswartz) teaches method and system for communicating with a customer's computer based on the offline purchase history of the consumer, comprising:

**Claims 1, 18 and 21.**

Storing registered customer purchase history information (*historical interaction data*) in a computerized, network-accessible database (C. 5, L. 39-41);

receiving current URL request (current interaction) from the registered customer over the Internet (C. 13, L. 58-60) to identify interaction data associated with previous registered customer purchase history information (C. 9, L. 57-60); said previous registered customer purchase history information including information which is relevant to the current interaction and including registered customer credit card number, social security card number, driver's license number, checking account number, shopper card number, shopper loyalty card number, customer's name, address and telephone number (C. 5, L. 56-61);

accessing said computerized, network-accessible database in accordance with the received current URL request to obtain said identified interaction data thereby providing interactive information which is relevant to the interaction with the registered customer (C. 9, L. 57-60).

Gardenswartz does not specifically teach that providing said interactive information which is relevant to the interaction with the registered customer includes providing a *context* for the communication received from the customer.

However, the Merriam-Webster's Collegiate Dictionary (10th ed.) defines "context" as "the interrelated conditions in which something exists or occurs" (p. 250).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Gardenswartz to include that said providing interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer, because without indication in the specification the advantages of using the term "context" over the prior art, it appears that said term "context" is obvious variation of said interactive information associated with a particular purchase history classification.

**Claims 2** and **20**. Receiving communication over the Internet (C. 13, L. 58-60).

**Claim 3.** Storing customer purchase history information in a database (C. 5, L. 39-41), and classifying said data into one or more purchase behavior classification (C. 7, L. 5-7).

**Claim 4.** Transmitting said purchase history data to the device (advertiser's server) through which the communication was received (C. 13, L. 58 – C. 14, L. 9).

**Claim 5.** Delivering said interactive information to the customer so that the customer can act upon receiving said information (C. 9, L. 31-38).

**Claim 7.** Said method, wherein the communication includes consumer identification data (C. 5, L. 55-61).

**Claim 8.** Gardenswartz teaches:

Storing registered customer purchase history information (*historical interaction data*) in a computerized, network-accessible database (C. 5, L. 39-41);

receiving current URL request (current interaction) from the registered customer over the Internet (C. 13, L. 58-60) to identify interaction data associated with previous registered customer purchase history information (C. 9, L. 57-60); said previous registered customer purchase history information including information which is relevant to the current interaction and including registered customer credit card number, social

security card number, driver's license number, checking account number, shopper card number, shopper loyalty card number, customer's name, address and telephone number (C. 5, L. 56-61);

accessing said computerized, network-accessible database in accordance with the received current URL request to obtain said identified interaction data thereby providing interactive information which is relevant to the interaction with the registered customer (C. 9, L. 57-60).

Gardenswartz does not specifically teach that providing said interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer.

However, the Merriam-Webster's Collegiate Dictionary (10th ed.) defines "context" as "the interrelated conditions in which something exists or occurs" (p. 250).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Gardenswartz to include that said providing interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer, because without indication in the specification the advantages of using the term "context" over the prior art, it appears that said term "context" is obvious variation of said interactive information associated with a particular purchase history classification.

**Claim 9.** Receiving communication over the Internet (C. 13, L. 58-60).

**Claim 10.** Storing customer purchase history data (*historical interaction data*) in a database (C. 5, L. 39-41), and classifying said data into one or more purchase behavior classification (C. 7, L. 5-7).

**Claim 11.** Presenting interactive information for the customer, wherein said interactive information is associated with a particular purchase history classification so that the customer receives interactive information that reflects his or her offline purchase history (C. 9, L. 57-60).

**Claim 12.** Transmitting said purchase history data to the device (advertiser's server) through which the communication was received (C. 13, L. 58 – C. 14, L. 9).

**Claim 13.** Gardenswartz teaches:

Storing registered customer purchase history information (*historical interaction data*) in a computerized, network-accessible database (C. 5, L. 39-41);

receiving current URL request (current interaction) from the registered customer over the Internet (C. 13, L. 58-60) to identify interaction data associated with previous registered customer purchase history information (C. 9, L. 57-60); said previous registered customer purchase history information including information which is relevant to the current interaction and including registered customer credit card number, social security card number, driver's license number, checking account number, shopper card number, shopper loyalty card number, customer's name, address and telephone number (C. 5, L. 56-61);

accessing said computerized, network-accessible database in accordance with the received current URL request to obtain said identified interaction data thereby providing interactive information which is relevant to the interaction with the registered customer (C. 9, L. 57-60);

generating a response to the current URL request in accordance with the registered customer identification data, accessed registered customer purchase history information and interaction with the customer, delivering said response to the customer via e-mail (C. 7, L. 25).

Gardenswartz does not specifically teach that providing said interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer.

However, the Merriam-Webster's Collegiate Dictionary (10th ed.) defines "context" as "the interrelated conditions in which something exists or occurs" (p. 250).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Gardenswartz to include that said providing interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer, because without

indication in the specification the advantages of using the term "context" over the prior art, it appears that said term "context" is obvious variation of said interactive information associated with a particular purchase history classification.

Gardenswartz, also, does not specifically teach that said customer *request is received via e-mail*.

However, Gardenswartz does teach that said interactive information is delivered to the customer via e-mail (C. 7, L. 25), thereby suggesting interacting with the customer via e-mail.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Gardenswartz to include that said customer request is received via e-mail, because it would advantageously allow to transmit said request almost instantly, thereby save time.

**Claims 15 and 16.** Retrieving by customer's computers Web pages of the registration server via the Internet (C. 6, L. 48-56), thereby indicating *generating a template e-mail on the customer's terminal*.

**Claim 17.** Storing customer purchase history data (*historical interaction data*) in a database (C. 5, L. 39-41) and classifying said data into one or more purchase behavior classification (C. 7, L. 5-7).

**Claim 19.** A computer configured to generate interactive information to the customer (C. 6, L. 47-64; C. 13, L. 58-60).

**Claims 22-24.** Said system as in claim 21 (See reasoning applied to claim 21). Language as to the specific content of the *interaction data, associated data and retrieved data* is given no patentable weight. MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or <u>does not limit a claim to a particular structure</u> does not limit the scope of a claim or claim limitation.*"

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of Claims 22-24 are disclosed by the prior art as described herein. Also, as described, the limitations of the claim do not distinguish the claimed apparatus from the prior art.

### (10) Response to Argument

Applicant argues, that Gardenswartz fails to disclose *providing a context for the current interaction between the business and the consumer based on interaction data associated with a previous interaction between the business and the consumer, which is relevant to said current interaction.*

In response to this argument it is noted, that Gardenswartz explicitly teaches that upon receiving current URL request (current interaction) from the registered customer over the Internet (C. 13, L. 58-60), the system matches the cookie number received from the registered customer computer to the modified targeted ad profile associated with the cookie number, and then delivers a content to the registered customer computer based on at least one of the purchase behavior (*previous interaction*) (C. 13, L. 65 – C. 14, L. 4). Furthermore, in another embodiment Gardenswartz teaches that upon receiving inputs from the registered customers over the telephone, interactive voice responses (IVR) are generated so that each IVR message is associated with a particular purchase history, and each consumer hears an IVR that reflects his or her offline purchase history (C. 9, L. 57-60). Gardenswartz further defines other relevant to the current interaction with the customer information, including customer credit card number, social security card number, driver's license number, checking account number, shopper card number, shopper loyalty card number, customer's name, address and telephone number (C. 5, L. 56-61).

As per term "context" per se, the Merriam-Webster's Collegiate Dictionary (10th ed.) defines "context" as "the interrelated conditions in which something exists or occurs" (p. 250). Examiner stipulates that Gardenswartz' teachings of accessing customer purchase history information, including customer credit card number, account

number, shopper card number and shopper loyalty card number, in order to response to customer inquiry, disclose creating interrelated conditions reflecting prior and current customer shopping behavior in which current interaction with the customer is conducted based on previous customer shopping behavior.

## (11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Igor N. Borissov

Conferees:

John W. Hayes

Sam Sough